

REMARKS

This application has been carefully reviewed in light of the Office Action dated May 6, 2005. Claims 1 and 3-17 remain pending in this application. Claims 1, 15, and 16 are the independent claims.

Applicants note with appreciation the indication that Claims 3-5, 8, 9, 12, 13, and 17 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim. Applicants respectfully refrain from so amending Claims 3-5, 8, 9, 12, 13, and 17 because they believe their respective base claim to be allowable.

On the merits, the Office Action rejected Claims 1, 6, 7, 10, 11, and 14-16 were rejected under 35 U.S.C. 102(a) as being anticipated by Underbrink (U.S. Patent No. 6,114,992; hereinafter "Underbrink"). Applicants respectfully traverse the rejection for the following reasons.

The Office Action argues that Underbrink teaches "using measured frequencies of a previous measurement as well as estimated or known maximum changes to narrow the range of frequency searching" (page 3, paragraph 2 of the Office Action). The Office Action continues that the estimated or known changes of Underbrink are used to narrow the range of searching. The Office Action argues that the measured frequency of the previous signal and the

estimated or known maximum changes define a range of frequencies that meets the scope of Applicants "frequency information relating to measured variations in the frequency of the first signal." The Office Action argues that Underbrink's recitation that predicted changes are based on statistical probability that may be derived from real-life trials or computer simulations (See, e.g., Underbrink, Col. 7, lines 1-22) meets Applicants' "measured variations" limitation. Applicants respectfully disagree with this assertion for the following reasons.

Underbrink's prediction of a maximum effect that can occur fails to recite or suggest using measured variations in the frequency of the first acquired signal to acquire a second signal. Rather, Underbrink's statistical probability that is based on "real-life trials" does not recite or suggest measuring variations in the frequency of the first acquired signal. The Office Action essentially states that the "real-life trials" inherently or otherwise recites or suggests trials based upon the first acquired signal. There is no basis for this assumption. Underbrink does not explicitly say that the "real-life trials" are made on the first acquired signal. Applicants respectfully note that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even

probabilities are not enough; necessity recognized by those of skill in the art is required.¹ The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective

¹ The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Qelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgig v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

evidence or cogent technical reasoning to support a contention of inherency.²

Simply because, as the Office Action alleges, Underbrink recites that the statistical probability curve can be generated from "real-life trials" does not meet the requirements of an inherency argument.

The Office Action proceeds to argue that Doppler effects are, by definition, variations in frequency based on the movement of the source and/or receiver. This may be true, however, Underbrink fails to recite or suggest using measured variations in the frequency of the first acquired signal to acquire a second signal.

Applicants respectfully traverse the rejection of Claim 1 over Underbrink for at least these reasons.

Additionally, in response to the Office Action's allegation that the specification lacks support for a "single dwell" Applicants respectfully submit that Page 2, paragraph 2 and the whole of page 7 at least provide support for this element. Further, lack of support does not give rise to a § 102 rejection and Applicants respectfully request withdrawal of the § 102 rejection under this basis of reasoning. A dwell is a single code phase check which in the context of dispreading a GPS spread spectrum signal is seeing if you can find in the received signal a

² "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).


signal modulated with the target PRN code for any given frequency/code phase combination (see, e.g., Page 2, paragraph 2). The information in Underbrink is not used "in the course of a single dwell." Rather, Underbrink uses the information after looking within a signal and postulating the Doppler effect. Thus Applicants additionally traverse the § 102 rejection over Underbrink.

Claims 15 and 16 recite a GPS receiver and a mobile telephone, respectively, each of which corresponds to the method of Claim 1 and Applicants believe them to be patentable for at least the same reasons.

Claims 3-14 depend from one or another of the Claims discussed above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 3-14 to be independently patentable and request separate consideration of each claim.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application. Applicants' undersigned attorney may be reached by telephone at the number given below.

Respectfully submitted,

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September 6, 2005